

REMARKS

Formal Matters

Claims 19-26, 38-42 and 46 are pending in the instant application. Claim 19 has been amended, and Claims 47-53 have been added. Support for the amendments to Claim 19 can be found, for example, but not limited by paragraphs 82, 84 and 86. Support for newly added Claims 47-53 can be found, for example, but not limited by, paragraphs 81-86. No new matter has been added.

In view of the following remarks, Applicants respectfully request reconsideration of Claims 19-26, 38-42 and 46-53, the only claims under examination in the instant application.

Claim Rejections- 35 U.S.C. § 103(a)

In the Office Action dated Oct. 16, 2007, Claims 19-21, 23, 26, 38 and 46 of the instant application were rejected by the Examiner under 35 U.S.C. § 103(a) as allegedly obvious over Cassin et al. (US 5,910,287; filing date June 3, 1977; hereafter Cassin) in view of Gilby, et al. (US 6,239,871; filing date Aug. 24, 1999; hereafter Gilby). As the grounds for rejection are the same as entered in the Office Action dated May 2, 2007, the Applicants wish to address the Examiner's Response to Arguments entered into the Action of Oct. 16, 2007.

In addition to the three criteria for establishing a *prima facie* obviousness, as stated in the M.P.E.P § 2143, and previously entered in the Applicants' Response dated July 27, 2007, it is additionally stated in the M.P.E.P. 2143.01, with respect to *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004):

The court emphasized that the proper inquiry is "whether there is something in the prior art as a whole to suggest the *desirability*, and thus the obviousness, of making the combination,' not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available."

By the Examiner's own admission, Cassin does not provide any teaching on lenses that can be incorporated into a device, such as embodiments of a microcard of the instant application. As cited in the above, one can conclude from the Examiner's admission, given the absence of any relevant teaching of lenses in Cassin, that therefore, Cassin fails to suggest the desirability or obviousness to combine with any reference, such as, for example Gilby, to arrive at embodiments of microcards of the instant application.

Regarding Gilby as a reference, the Examiner states that Gilby discloses the use of an aplanatic lens for conducting fluorescence detection, thereby establishing motivation for using

aplanatic lenses in embodiments of microcards of the instant application. The Applicants respectfully submit that Gilby applied the knowledge well known in the art of optics to a particular problem for remote detection in a single capillary, since Gilby clearly neither invented aplanatic lenses nor discovered their benefit in eliminating spherical aberrations. Based on the Examiner's reasoning, Gilby would be rendered obvious by virtue of the ready knowledge in the art concerning aplanatic lenses, which knowledge existed at the time of the filing of Gilby. There is nothing in the teachings of Gilby that suggest the desirability of aplanatic lenses to one of ordinary skill in the art for solving the problem addressed in the instant application. In fact, the teachings of Gilby for the use of a conventional lens requiring grinding into a hyper-hemisphere with a planar surface located to focus remotely within a capillary *teaches away* from the teachings of the instant application for embodiments of a device incorporating numerous lenses formed in the device, which lenses facilitate the detection of a plurality of samples.

Therefore, as Cassin fails to suggest any desirability to combine with Gilby, and Gilby teaches away from embodiments of the microcard of the instant application, no *prima facie* case of obviousness has been demonstrated for Claim 19 in the combination of Cassin and Gilby. The Applicants further submit that Claims 20-26, 38-42 and 46 are not obvious over the cited references for at least the same reasoning as applied in the above for the claim from which they depend. Accordingly, the Applicants respectfully request that the rejection be withdrawn.

Additionally, Claim 19 has been rejected as allegedly obvious over Cassin in view of Schroeder, et al. (US 5,355,215; filing date Oct. 11, 1994; hereafter Schroeder) as evidenced by Claytor (US 4,787, 722; filing date Nov. 29, 1988). In the Action, the Examiner states that the arguments presented in the Applicants' Response of July 27, 2007, are not persuasive, as they attack the references individually. As clearly stated in the Response, the cited references fail to provide the necessary motivation, which motivation cannot be found either in the references alone, or in combination. As stated in the M.P.E.P. 2143.01, and quoted above, the proper inquiry is whether or not there is something as a whole that suggests a desirability to combine.

The Applicants maintain that, for example, the failure of Cassin to provide any motivation as a prior art reference, as evidenced by the Examiner's admission, would therefore provide no desirability to combine Cassin with another reference, for example, such as Schroeder. Moreover, argumentation was also set out in the Response regarding the combination of Cassin and Schroeder teaching away from embodiments of microcards of the instant application.

As such, no *prima facie* case of obviousness has been asserted, and the Applicants request that the rejection of Claim 19 and its dependent Claim 39 be withdrawn.

CONCLUSION

The Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact me at the telephone number listed below.

Fee Authorization

Should any extension of time and/or fee be necessary for the timely submission of this paper, such extension of time is hereby requested, and the Commissioner is hereby authorized to charge **Deposit Account No. 01-2213 (order no. 4847)**. Any deficiency or overpayment should be charged or credited to this deposit account.

Respectfully submitted,

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